

## REMARKS

Claim Disposition

Claims 1 – 34 are pending in the application. Claims 1 – 6, 8 – 12, 20, 23 – 28, and 30 – 34 have been rejected. Claims 7, 13-19, 21, 22, and 29 have been allowed. Claim 10 has been amended to improve the wording to address the Examiner's concerns. The amendments provide further clarification of the invention. No new matter is added.

Claim Rejections - 35 USC § 112

Claim 10 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states:

"Claims 10 recites the limitations "its", it is unclear what "its" is. Since the claim is unclear, the claim has been interpreted as set forth below."

Applicants have amended Claim 10 to address the Examiner's concerns.

Claim Rejections – 35 U.S.C. § 102(b)

Claims 1 – 6, 8 – 12, 20, 23 – 28, and 30 – 33 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,048,630 to Schaffer. Applicants respectfully contend that Schaffer does not teach or disclose each element of the invention.

To anticipate a claim under 35 U.S.C. §102, a single source must contain all of the elements of the claim. Lewmar Marine Inc. v. Bariant, Inc., 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

As to Claims 1, 2, 3, 4, 12, 20, 23, 24, 25, and 26 Applicants respectfully contend that Schaffer does not teach or disclose each element of the invention "arranged as in the claim". Specifically, with respect to Claims 1, 20, and 23, Schaffer does not teach or disclose, "a torque-assist function responsive to a signal indicative of an input device torque for providing a torque-assist command to a motor; and a steering-pull compensator responsive to a signal indicative of a valid detection cycle for modifying said torque-assist command to the motor by an offset corresponding to a detected steering-pull condition." Schaffer is drawn to a hydraulic steering system including a hydraulic actuator. Schaffer does not teach or disclose a controller with a torque assist function as claimed. In fact, there is no controller with a torque assist function taught by Schaffer. Schaffer merely discloses a motor employed to manipulate the fluid applied to the actuator disclosed therein.

Applicants respectfully acknowledge the Examiner's comments regarding the prior response and respectfully submit that the Examiner is employing and overly broad meaning for the term "motor". The claims are to be given their plain meaning and are not to be construed in contravention of the claims or the teachings of the specifications. The plain meaning of the term especially in the context given is of an electric machine. The specification and figures clearly teach the terminology motor is intended to be an electric machine. The definition the Examiner suggests attempts to utilize the term "motor" as an adjective meaning 'to impart motion' rather than as a noun. The context of the claim and the fact the term is introduced with an article clearly indicates that the term is to be used as a noun. The Examiner has employed an impermissible interpretation of the term "motor". Therefore, as presented earlier, Schaffer clearly does not teach or disclose, "a torque-assist function responsive to a signal indicative of an input device torque for providing a torque-assist command to a motor; and a steering-pull compensator responsive to a signal indicative of a valid detection cycle for modifying said torque-assist command to the motor by an offset corresponding to a detected steering-pull condition." Furthermore, because Schaffer does not disclose or teach an element of the invention it cannot anticipate the Applicants' claims. Thus, Claims 1, 20, and 23 are allowable, the rejections are improper, and they should be withdrawn. Alternatively, Applicants respectfully suggest that an amendment adding additional clarification could be submitted to change the terminology "motor" to "electric motor" if considered appropriate.

In addition, Schaffer does not teach or disclose, "a steering-pull compensator responsive to a signal indicative of a valid detection cycle ..." There is no teaching in Schaffer as to a valid/invalid detection cycle, nor a signal indicative thereof. Once again, Applicants respectfully acknowledge the Examiners responses concerning this terminology. However, Applicants respectfully submit that the Examiner mischaracterizes the teachings of Schaffer in this regard. Schaffer merely discloses an example sampling duration for a given sample period. This is not equivalent to evaluation of a detection cycle to determine its validity as taught in the specification and claimed. Therefore, because Schaffer does not disclose or teach an element of the invention it cannot anticipate the Applicants' claims. Thus, Claims 1, 20, and 23 are allowable, the rejections are improper, and they should be withdrawn.

With respect to Claims 2 and 24, these Claims include the limitations distinguished above for Claims 1, 20, and 23, thus, they cannot be anticipated by Schaffer. In addition, there is not teaching of a torque assist command in Schaffer. Thus, Claims 2 and 24 are allowable, the rejections are improper, and they should be withdrawn.

With respect to Claims 3 and 25, once again, these claims include the limitations distinguished above for Claims 1, 20, and 23, thus, they cannot be anticipated by Schaffer. Moreover, contrary to the Examiner's suggestion, there is no disclosure of "a filter responsive to the signal indicative of input device torque" in the section relied upon by the Examiner. The sections relied upon disclose teachings with respect to sampling signals and observation, not filtering. Thus, Claims 2 and 24 are allowable, the rejections are improper, and they should be withdrawn.

Similarly, with respect to Claims 4 and 26, these claims include the limitations distinguished above for Claims 1, 20, and 23, thus, they cannot be anticipated by Schaffer. In addition, Schaffer does not teach or disclose a controller with a steering-pull compensator comprising "a condition processing block for determining if the vehicle is being driven in a substantially straight path". The Examiner suggests that because Schaffer has limited the operation of the functions disclosed therein to "deflections of the driving shaft 20 are up to about 10 - 15 degrees" that this is equivalent to the claimed elements. However, Schaffer provides no quantitative teachings as to the relation between the rotation of the driving shaft 20 and the vehicle path. There is no teaching that this is "a substantially straight path." Thus, Claims 4 and 26 are allowable, the rejections are improper, and they should be withdrawn.

With respect to Claims 5, 6, 8, 9, 10, 11, 27, 28, 30, 31, 32, and 33, Applicants respectfully contend that the Examiner has mischaracterized the teachings of Schaffer. Schaffer does not teach or disclose, an enable block for validating the detected steering-pull condition," nor does Schaffer teach or disclose an enable switch. The Examiner also relies upon Figure 6. There is no teaching or disclosure of an enable block for validating the detected steering-pull condition nor and enable switch in Figure 6. Moreover, with respect to Claims 10 and 32, nothing in Figure 6 of Schaffer discloses or teaches, "memory switch for receiving its own output signal at its primary input terminal." Furthermore, with respect to Claims 11 and 33, nothing in Figure 6 of Schaffer discloses or teaches "a function block for providing a signal to a non-inverting input of the summing function." Additional clarification as to the Examiner's rejection is respectfully requested. Moreover, these claims include the limitations distinguished above for Claims 1, 20, and 23, thus, they cannot be anticipated by Schaffer. Therefore, because Schaffer does not disclose or teach an element of the invention it cannot anticipate the Applicants' claims. Thus, Claims 5, 6, 8, 9, 10, 11, 27, 28, 30, 31, 32, and 33 are allowable, the rejections are improper, and they should be withdrawn.

*Claim Rejections – 35 U.S.C. § 103(a)*

Claims 34 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,048,630 to Schaffer in view of U.S. Patent No. 6,272,947 to Howard.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143.

Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Finally, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing ... that the proposed modification of the prior art must have had a reasonable expectation of success. MPEP 2143.02. Moreover, the suggested modification cannot change the principle of operation of a reference. MPEP 2143.01.

Applicants respectfully contend that the Examiner has mischaracterized the teachings of at least Schaffer and/or Howard. Once again, this claim includes the limitations distinguished above for Claim 23, thus, is cannot be rendered unpatentable by Schaffer. Therefore, because Schaffer does not disclose or teach an element of the invention, the Examiner has not made a prima facie case for obviousness. Thus, Claim 34 is allowable, the rejection is improper, and it should be withdrawn.

Furthermore, the Examiner has presented no justification for the suggested combination of references. There is clearly no teaching whatsoever in Schaffer or Howard that would motivate the suggested combination. Clearly the Examiner has merely employed improper hindsight to locate in the references the various elements of the claims. Therefore, because there is no motivation to combine Schaffer and Howard, the Examiner has not made a prima facie case for obviousness. Thus, Claim 34 is allowable, the rejection is improper, and it should be withdrawn.

The arguments and amendments here presented are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims have not been amended to overcome the prior art and therefore, no presumption should

attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicants are entitled has been surrendered. Support for these amendments can be found in the specification and claims as originally filed. No new matter has been introduced. Allowance of the claims is respectfully requested in view of the amendments and following remarks. Moreover, no amendments as presented alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection.

It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicants. Accordingly, reconsideration and withdrawal of the rejections are requested.

In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are additional charges with respect to this matter or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully Submitted,

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